

III. REMARKS

1. Claims 12-19 are pending in this application.

2. Applicant once again re-asserts its contention regarding the legitimacy of the Office Action mailed May 5, 2004. A petition under 37 C.F.R. §1.181 was filed by Applicant on May 20, 2004 citing reasons why the Office Action should not have been issued. As of the date of filing this response, Applicant has not received a decision on the petition. Applicant once again states that proper grounds to re-open prosecution in this application after the Decision on Appeal of March 31, 2003 have not been presented. Consideration of Applicant's petition dated May 20, 2004 is respectfully solicited prior to any further action on the Office action.

3. It is respectfully submitted that claims 12-19 are not unpatentable over Saji (U.S. Patent No. 5,476,486) in view of Yamamoto (U.S. Patent No. 5,327,482) under 35 U.S.C. §103(a).

Claims 12-19 were previously rejected by the Examiner under 35 U.S.C. §103(a) over the combination of Saji and French (U.S. Patent No. 5,760,690). This rejection was reversed by the Board. (Decision, March 31, 2003, page 4). In particular, the Board determined that the Saji reference was not relevant with respect to Applicant's invention. In the opinion of March 31, 2003 it is stated that "Saji does not recognize the problem of theft for cordless telephone sets. Saji is concerned solely with the problem of insuring that the cordless radio set is being properly charged once [it is] placed in the charging stand." (Decision, March 31, 2003, page 8). The Board also states that "Saji does not provide any evidence that the cordless telephone set is expensive nor any evidence that there would be data stored in the

cordless telephone set that could be misappropriated." (Decision, March 31, 2003, page 9). Thus, the Board concluded that "[w]e fail to find that Saji suggests a reason to provide an anti-theft mechanism for Saji's cordless telephone. Furthermore, we find that Saji is only concerned with the problem of proper charging. Therefore, we fail to find that one of ordinary skill in the art would have reason to take the Saji cordless telephone set and modify it and protect it against theft." (Decision, March 31, 2003, page 9). In light of the foregoing, and Applicant's previous arguments concerning Saji, Applicant once again submits that Saji is not relevant against Applicant's invention for purposes of 35 U.S.C. §103(a), and cannot be used to establish a *prima facie* case of obviousness of Applicant's invention.

Even if Saji were relevant for purposes of 35 U.S.C. §103(a), the combination of Yamamoto with Saji does not disclose or suggest each feature of Applicant's invention as is required for purposes of 35 U.S.C. §103(a). Furthermore, neither Saji nor Yamamoto provide any objective teaching that would lead one of ordinary skill in the art to modify Saji or Yamamoto to obtain Applicant's invention, and the combination still does not achieve Applicant's invention as recited in the claims.

Yamamoto relates to a public cordless telephone that includes a branch unit 200 connected to a charger 300. The charger 300 is connected to the base unit 100. (See FIG. 1, Col. 1, lines 15-25). The system of Yamamoto can detect the charge in the battery of the branch unit when the branch unit is mounted to the charger. Yamamoto "inhibits use" of the branch unit when the "remaining charge" is insufficient to make a call. (Abstract, lines 11-14). The system of Yamamoto also includes a "theft

detection function" that continuously transmits a theft signal from the branch unit until the battery of the branch unit is exhausted. The above, however, is not Applicant's invention.

Independent claim 12, present in the application, is reproduced as follows:

12. A radio telephone including a rechargeable power supply and having coupling means for connecting to a charging unit for charging the rechargeable power supply, the radio telephone comprising sensing means associated with the coupling means and operable to sense the absence or the presence of the charging unit being connected to the radio telephone, and inhibiting means configured to be responsive to the sensing means in such a manner that when the sensing means senses absence of the charging unit the inhibiting means automatically inhibits operation of the radio telephone.

These features are neither disclosed nor suggested by Yamamoto, either alone or in combination with Saji.

Yamamoto does not disclose inhibiting means that is configured to be responsive to the sensing means which senses the absence or presence of the charging means such that when the sensing means senses the absence of the charging unit the inhibiting means automatically inhibits the operation of the radio telephone.

The Examiner refers to Col. 8, lines 49-54 and 63-66, as well as FIG. 19 in support of the reasoning for the rejection. However, these portions of Yamamoto do not disclose or suggest the features of claim 12, and do not provide the requisite motivation to modify Saji to achieve Applicant's invention. The cited

portions of Yamamoto make it clear that when a branch unit 200 is mounted on the charger this causes the return of a card previously inserted in the card reader to be returned to the user. The point about battery exhaustion is that it is undesirable to allow the batteries to drain and thus battery exhaustion is to be prevented. What Yamamoto states in this regard is that if the battery of the branch unit 200 is exhausted, the branch unit 200 will be put in an inoperative state. (Col. 8, lines 62-66). Clearly, what this portion of Yamamoto teaches is that if the battery is depleted, the branch unit becomes inoperative. Certainly it makes some sense that if the battery power of the device is drained, the device will become non-functional unless there is some source of back-up power. This, however, is not what is claimed by Applicant.

Yamamoto does not, contrary to the Examiner's assertion, teach that the radio telephone detects the absence of the charging unit 200 and inhibits the use of the phone. The feature 54 in Yamamoto is not a sensing means that senses the absence/presence of the charging unit 200 handset. As explained in Col. 12, line 45 to Col. 13, line 30, the feature 54 is a theft detector having a timer. It receives inputs from the electric field receiver 51 an out-of-synchronisation detection signal 56, from the synchroniser and a line error detection signal 57 from the synchroniser 52, and generates a theft signal when these signals continue for more than a predetermined length of time. It is not in any way linked to the charging unit 200 and certainly is not based on the sensing the absence or presence of the charging means.

Thus, at least that feature of Applicant's invention is not disclosed or suggested by Yamamoto or the combination of Saji in view of Yamamoto.

Claims 13-18 depend from claim 12 and should be allowable at least in view of the dependencies. Furthermore, with regard to claim 13, Saji in view of Yamamoto does not disclose or suggest that the sensor and inhibiting means are operative for a power on mode of the phone. There is no disclosure in Yamamoto of "inhibiting means" as claimed by Applicant. All that Col. 8, lines 45-66 states is that it is undesirable to allow the battery of the branch unit 200 to be exhausted, which results in the branch unit 200 becoming inoperative, which is clearly due to the lack of power. A drained battery is not the same as the "inhibiting means" recited and claimed by Applicant.

With regard to claim 14, Yamamoto again does not disclose or suggest the "inhibiting means" as claimed by Applicant. Applicant also respectfully traverses the Examiner's statement that Yamamoto inherently inhibits access to information stored in the radio telephone as is claimed by Applicant. Perhaps when the battery is dead, information cannot be accessed. That is not however, the same as what Applicant is claiming.

With regard to claim 15, Yamamoto does not, contrary to the Examiner's statement, inhibit operation of the phone when the handset is absent from the charger. All that Col. 8, lines 63-66 recites, is that the battery can be "undesirably" exhausted. This is not the same as inhibiting an outgoing call as claimed by Applicant.

Similar arguments apply to the patentability of claims 17 and 18.

Claim 19 recites a method defining operation of the invention. As noted above, the combination of Saji and Yamamoto fails to at least disclose or suggest sensing whether the radio telephone is coupled to a charging device and "automatically inhibiting" operation of the radio telephone responsive to "sensing absence" of the charging device. Thus, claim 19 should also be allowable.

4. Furthermore, there is no motivation to combine Saji with Yamamoto to achieve Applicant's invention and the resulting combination does not disclose or suggest each feature of Applicant's invention as is required to establish a prima facie case of obviousness under 35 U.S.C. §103(a).

The burden of obviousness requires some objective teaching to make the combination of references. In re Lee, 277 F.3rd 1338, 1343; 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). There is no such teaching in either Saji or Yamamoto.

Saji relates to a cordless telephone set that signals an alarm if and when the respective recharging contacts between the phone and the charger are not properly coupled together. Saji does not allude to the problem of the phone being stolen, it is simply concerned with the problem of ensuring that the telephone battery is properly recharged. Thus, starting from Saji, there would be no technical motivation at all to make any modifications to Saji's phone in the area of security since Saji does not recognize the problem of the theft for cordless telephone sets.

The Board concluded that Saji does not provide a reason to provide an anti-theft mechanism to Saji's cordless phone, and there is no reason why one of ordinary skill in the art would "take the Saji cordless telephone set and modify it and protect it against theft."

Nothing with Saji has changed since the rendering of the Board's opinion on March 31, 2003 to change this holding with regard to Saji. The Examiner should respect the decision of the Board and not now attempt to reapply a reference that was held **not to be applicable or relevant** for purposes of 35 U.S.C. §103(a)

Yamamoto relies on an "out-of-synchronism" to take place to generate a theft signal. (Col. 13, lines 4-8). Saji does not discuss such a phenomenon since it only deals with proper coupling of the charging contacts between the phone and the charger.

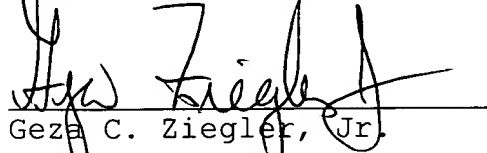
Thus, there is no motivation to combine Saji with Yamamoto to achieve Applicant's invention for purposes of 35 U.S.C. §103(a). Furthermore, for the reasons stated above, this combination does not disclose or suggest each feature of Applicant's invention. Thus, obviousness is not established, and Applicant's invention is patentable.

5. In conclusion, Applicant respectfully submits that in light of the Board's decision and its holding with regard to Saji, there is simply no basis to re-open prosecution on this application. In any event, the proposed combination does not meet the requirements of 35 U.S.C. §103(a), and does not disclose or suggest each feature of Applicant's invention.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


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